REMARKS

Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks. Claims 1-8 were pending prior to the Final Office Action. Claims 9-30 have been added through this Reply. Therefore, claims 1-30 are pending. Claims 1, 4, and 5 are independent.

§ 103 REJECTION - STOKES, INOUE

Claims 1-8 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Stokes et al. (www.w3.org/Graphics/Color/sRGB.html, hereinafter "Stokes") in view of Inoue et al. (USPN 6,128,407, hereinafter "Inoue"). Applicants respectfully traverse.

For a Section 103 rejection to be proper, a *prima facie* case of obviousness must be established. *See M.P.E.P. 2142.* One requirement to establish *prima facie case* of obviousness is that the prior art references, when combined, must teach or suggest all claim limitations. *See M.P.E.P. 2142; M.P.E.P. 706.02(j).* Thus, if the cited references fail to teach or

suggest one or more elements, then the rejection is improper and must be withdrawn.

In this instance, independent claims 1, 4, and 5 recite, in part, "wherein the image data is corrected without changing the gradation of the image." The Examiner admits that such feature is not taught or suggested by Stokes.

However, contrary to the Examiner's assertion, Inoue cannot be relied upon to teach or suggest this feature. Even the Examiner's own words indicates that Inoue fails to teach or suggest the above-noted feature. The Examiner refers to column 2, lines 53-66 and states that Inoue's color image converter "executes color conversion, such that the degradation of color discrimination is **reduced**." *Emphasis added; See Final Office Action, page 4, 1st paragraph.* Clearly, a reduction in gradation **cannot** be equated to correcting image **without** changing the gradation.

Another requirement to establish *prima facie case* of obviousness is that there must be a suggestion or motivation within the cited reference(s) to modify the reference(s) as proposed in the Final Office Action. *See M.P.E.P. 2143.01.*

In this instance, the Examiner did not even allege any motivation or suggestion that would motivate one of ordinary skill to combine Stoke and Inoue, let alone demonstrate that such motivation or suggestion can be found within cited references.

It appears that an obviousness has been assumed merely on the assumption that the combination of the references includes all claimed elements. However, it is well established that even if the combination of the references teaches every element of the claimed invention (which is clearly NOT the case), without some motivation to combine, a rejection based on a *prima facie* case of obviousness is improper. *See MPEP 2143.01.*

It appears that the only motivation to combine has been gleaned from the teachings of the present application. This constitutes impermissible hindsight, however. *See MPEP 2141.* Simply put, there is no showing in the Final Office Action that the conclusion of obviousness was reached on the basis of facts gleaned from the prior art, and not from the claimed invention. *See MPEP 2143.*

In addition, the Examiner failed to consider the cited references in their entirety as required including disclosures

that teach away from the claimed invention. *See M.P.E.P. 2141.02*. If the cited reference(s) teach away from the claimed invention, then the combination is improper and the rejection must fail.

In this instance, Stokes clearly states that "In the encoding process, negative sRGB tristimulus values, and sRGB tristimulus values greater than 1.00 are not typically retained." Stokes goes on to state, "the luminance dynamic range and color gamut of RGB is limited to the tristimulus values between 0.0 and 1.0 by simple clipping." *See Stokes, page 11, top paragraph*. Clearly, if values are "not retained" or "clipped", then Stokes teaches away from the image data being corrected without changing the gradation of the image.

Therefore, for at least these reasons, claims 1, 4, and 5 are distinguishable over the combination of Stokes and Inoue. Claim 2-3 and 6-8 depend from independent claims 1, 4, and 5 directly or indirectly. Therefore, for at least the reasons stated with respect to the independent claims, these dependent claims are also distinguishable over the combination of Stokes and Inoue.

Applicants respectfully requests that the rejection of claims 1-8, based on Stokes and Inoue, be withdrawn.

NEW CLAIMS

Claims 9-30 have been added through this reply. Applicants respectfully submit that the new claims are distinguishable over all prior art of record. Applicants respectfully requests that the new claims be allowed.

CONCLUSION

All objections and rejections raised in the Final Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact Hyung Sohn (Reg. No. 44,346), to conduct an interview in an effort to expedite prosecution in connection with the present application.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee of $110.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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